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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,625	01/14/2004	Tomomi Takata	CFA00041US	6219

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Canon U.S.A. Inc.
Intellectual Property Department
15975 Alton Parkway
Irvine, CA 92618-3731

EXAMINER

QUELER, ADAM M

ART UNIT PAPER NUMBER

2178

DATE MAILED: 11/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/758,625

Applicant(s)

TAKATA ET AL.

Examiner

Adam M. Queler

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3 and 5-22 is/are pending in the application.
- 4a) Of the above claim(s) 5 and 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,6,7 and 9-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Amendment filed 08/21/2006
2. Claims 1, 3, 5-22 are pending in the case. Claims 1, 3, and 5-8 are independent claims.

Election/Restrictions

3. Applicant's election without traverse of group I in the reply filed on 08/21/2006 is acknowledged. It is noted that claim 9 is no longer part of Group II
4. Claims 5 and 8 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in the reply filed on 08/21/2006.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. **Claims 6-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. .**

MPEP 2106.01 reads as follows:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Claims 6 and 7 defines an apparatus embodying functional descriptive material. However, the claim does not define a computer-readable medium or memory and is thus non-statutory for that reason (i.e., “When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized” – MPEP 2106.01). That is, the scope of the presently claimed apparatus can range from paper on which the program is written, to a program simply contemplated and memorized by a person. Any amendment to the claim should be commensurate with its corresponding disclosure.

In this case the specification makes clear that the apparatus can include the reading of a computer for its function (pp. 38-40). Therefore the interpretation of the apparatus's scope is not limited to statutory embodiments. The term apparatus itself does not carry any implicit meaning that would exclude this interpretation of the apparatus as non-functional descriptive data, for example as just code. Adding the term “unit” does nothing to remedy this as a unit can still be reasonably interpreted to mean a unit of code.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. **Claims 1, 3, 6, 7 and 9-22 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps.** See MPEP § 2172.01. The omitted steps are: Writing the reliability information to the meta-data. Making sure that the meta-data contains the reliability information that appears to be specific to the instant invention is clearly essential to practice the invention as the determining step relies on this information.

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. **Claims 6, 7, 16-18 and 19-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.**

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There does not appear to be any basis in the specification for the addition of "units" to the claim.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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12. Claims 1, 6, 9, 10-12, and 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Sull (US 20020069218A1, 6/6/2002).

Regarding independent claim(s) 1, 6, 9, Sull teaches receiving operating information about an editing operation, receiving operation information about an editing operation, determining, in accordance, whether the metadata is usable for edited multimedia content edited by the editing operating adding the metadata to the edited multimedia content if the metadata is determined to be usable. (para. 473). Sull does disclose that a determination is made to see if it is to be copied, that is, if it is reliable. This check is directly in response to the operation taking place so the so the determination is based on the information about that operation. This is inherent because the purpose of this aspect of the invention is to determine if the meta-data is still valid given the operation (para. 31). Therefore the proximity and order of the steps set forth a reasonable basis in technical reasoning that the operation is used for the check. The check is in essence, determining whether the meta-data is reliable, or is not reliable. The result of the check is the reliability information.

Regarding dependent claim(s) 10, 16, Sull does disclose that a determination is made (“a check”) is made to see if it is to be copied, that is, if it is reliable (para. 473). The check is in essence, determining whether the meta-data is reliable, or is not reliable. The result of the check is the reliability information.

Regarding dependent claim(s) 11, 17, Sull teaches the reliability information is based on the operation information (para. 473).

Regarding dependent claim(s) 12, 18, Sull does not teach the percentages of the present invention. Sull is only concerned with either it is reliable or not, and adds it accordingly.

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Therefore Sull is comparing the reliability information with the predetermined reliability that it is reliable (in the terms of the invention, 100%).

Allowable Subject Matter

13. Claims 3, 7, 13, 14, 15, 19, 20, 21 and 22 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, as well as 35 U.S.C. 101 where applicable, set forth in this Office action.

14. The following is a statement of reasons for the indication of allowable subject matter: The closest available art is Sull. The wording of claim three to include adding the information to the metadata overcomes Sull. The remainder of cited documents is cited as background information.

Response to Arguments

15. **Applicant's arguments filed 8/21/06 have been fully considered but they are not persuasive..**

Regarding Applicant's remarks on §101 rejections:

Applicant alleges that because the claims are directed to apparatus they cannot be drawn to functional descriptive data. However, in this case the specification makes clear that the apparatus can include the reading of a computer for its function (pp. 38-40). Therefore the interpretation of the apparatus's scope is not limited to statutory embodiments. The term apparatus itself does not carry any implicit meaning that would exclude this interpretation of the apparatus as non-functional descriptive data, for example as just code. Adding the term "unit" does nothing to remedy that this unit can still be reasonably interpreted to mean a unit of code.

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16. Applicant's arguments with respect to the prior art have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

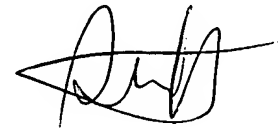
19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam M. Queler whose telephone number is (571) 272-4140. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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